



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,543	10/28/2005	Jaewhan Song	0002204USU/4105	4798
27623	7590	11/07/2008		
OHLANDT, GREELEY, RUGGIERO & PERLE, LLP ONE LANDMARK SQUARE, 10TH FLOOR STAMFORD, CT 06901			EXAMINER SAJJADI, FEREDOUN GHOTB	
			ART UNIT 1633	PAPER NUMBER
			MAIL DATE 11/07/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/531,543	Applicant(s) SONG ET AL.	
	Examiner FEREYDOUN G. SAJJADI	Art Unit 1633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 4-13 and 17-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/28/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to papers filed July 28, 2008. Applicant's response to restriction requirement of March 24, 2008 has been entered. No claims have been amended, cancelled, or newly added. Currently, claims 1-21 are pending in the application.

Election/Restrictions

Applicants' election of Group I (claims 1-3 and 14-16), drawn to a composition comprising Jab1 protein, is acknowledged. Applicant's species election of flavivirus and encephalitis (with traverse), is further acknowledged.

Accordingly, claims 4-13 and 17-21, have been withdrawn from further consideration by the Examiner, pursuant to 37 CFR 1.142(b), as being drawn to non-elected inventions.

Applicants' traversal for the species restriction, is on the grounds that searching and examining the subject matter of each of the species does not place a serious burden on the examiner. Applicants' arguments have been fully considered, but are not found persuasive.

Applicants have relied on U.S. restriction practice in a case where restriction was properly applied under rules for Unity of Invention, where restriction is not based upon search burden. Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more special technical features. In the instant case, the special technical feature shared by the Groups is anticipated by the prior art of Claret et al., as set forth on p. 3 of the previous office action. Applicants have not provided any evidence or arguments that Klein et al. has been improperly applied. Moreover, the species restriction indicated that each of the species is structurally and likely functionally distinct, capable of separate utility, and does not share a substantially common structural feature, to constitute a special feature under PCT Rule 13.2.

The election requirement is deemed proper and is therefore made **FINAL**.

Please note that after a final requirement for restriction, the Applicants, in addition to making any response due on the remainder of the action, may petition the Commissioner to review the requirement. Petition may be deferred until after final action on or allowance of

Art Unit: 1633

claims to the invention elected, but must be filed not later than appeal. A petition will not be considered if reconsideration of the requirement was not requested. (See § 1.181.).

Elected claims 1-3 and 14-16 are under current examination.

Objections to the Specification

The brief description of the figures is objected to, because the description of Figure 8 (p. 6), fails to describe the disclosures in Fig. 8, parts A and B.

The brief description of Figure 17 (p. 7) refers constructing a vector system, but Fig. 17 does not appear to show the same.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by GenBank Accession No: AF068223 (April 1, 2000).

The claims are directed to a composition comprising a Jab1 (Jun-activation binding domain) protein having an amino acid sequence of SEQ ID NO: 2, and encoded by a nucleotide sequence of SEQ ID NO: 1.

It should be noted that the claims state the intended use of the composition as a composition for treating or preventing a flavivirus infection. However, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed

Art Unit: 1633

invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir.1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) ("where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation"). Accordingly, claims 14-16 are not accorded any patentable weight, as they recite limitations regarding the intended use of the composition.

A Jab1 protein having an amino acid sequence of SEQ ID NO: 2 is taught by GenBank sequence submission AF068223 (limitation of claim 2). The protein is encoded by the nucleotide sequence additionally disclosed (nucleotide positions 22-1282 correspond to SEQ ID NO: 1; limitation of claim 3). GenBank accession No: AF068223 further identifies the sequences as that of Jab1 (limitation of claim 1).

If a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed.Cir. 1997). "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

Therefore by teaching all the limitations of the claims, GenBank AF068223 anticipates the instant invention as claimed.

Conclusion

Claims 1-3 and 14-16 are not allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FEREYDOUN G. SAJJADI whose telephone number is (571)272-3311. The examiner can normally be reached on 6:30 AM-3:30 PM EST.

Art Unit: 1633

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached on (571) 272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fereydoun G Sajjadi/
Examiner, Art Unit 1633